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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,444	07/22/2003	Frank L. M. DeCordt	5839	6444

7590 09/13/2004

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/624,444	Applicant(s) DECORDT ET AL.	
	Examiner Joseph D. Anthony	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to a corrosion inhibiting composition, classified in class 252, subclass 390.
 - II. Claims 7-11, drawn to a process for inhibiting corrosion of metal equipment, classified in class 422, subclass 9.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in scrubbing process of acidic gases.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with David L. Hedden on 08/25/04 a provisional election was made with traverse to prosecute the invention of Group II, claims 7-11.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 1-6 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

7. Claims 7-11 are objected to because they are dependent on non-elected base claims 1-6. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 8-11 are indefinite because claim 8 recites the limitation "the aqueous system". There is insufficient antecedent basis for this limitation in claim 7 from which claim 8 directly depends. Claims 9-11 are also being rejected here because they are dependent on a rejected base claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manaba et al. U.S. Patent Number 4,219,433 or Peters et al. U.S. Patent Number 4,404,113 or Mulvhill et al. U.S. Patent Number 5,415,896 or Haas et al. U.S. Patent number 6,464,899 or Miksic et al. U.S. Patent number 5,855,975 or Miksic et al. U.S. Patent Number 5,422,187.

Manabe et al discloses corrosion inhibiting anti-freeze compositions useful for automobile engines. The corrosion inhibitors used in the corrosion inhibiting anti-freeze compositions can be selected from benzoate, trialkanolamine, benzotriazole, tolyltriazole, and other types of corrosion inhibitors etc, and mixtures thereof, see abstract, column 2, line 59 to column 3, line 15, column 3, lines 41-53, column 4, lines 8-19 and Examples 1-2.

Peters et al discloses cooling liquids containing corrosion inhibitors that are used in internal combustion engines. The corrosion inhibitors used in the cooling liquid compositions can be selected from alkali metal benzoate, alkanolamine, benzotriazole, tolyltriazole, and other types of corrosion inhibitors etc, and mixtures thereof, abstract, column 2, lines 32-65, column 3, line 50 to column 4, line 6, examples and claims.

Mulvihill et al discloses railroad wheel flange lubrication compositions that comprise corrosion inhibitors. The corrosion inhibitors used in the lubricating compositions can be selected from sodium benzoate, alkanolamine, benzotriazole, tolyltriazole, and other types of corrosion inhibitors etc, and mixtures thereof, see abstract, column 2, lines 33-47, examples and claims.

Haas et al discloses putty compositions containing vapor phase corrosion inhibitors. The corrosion inhibitors used in the putty compositions can be selected from sodium benzoate, ammonium benzoate, trialkanolamine, benzotriazole, and other types of corrosion inhibitors etc, and mixtures thereof, column 5, line 31 or column 6, line 27, column 7, lines 1-5, Example 7 and the claims.

Miksic et al discloses anti-corrosion plastic films that contain vapor phase corrosion inhibitors. Preferred corrosion inhibitors used in the anti-corrosion plastic films can be selected from cyclohexylamine benzoate, ethylamine benzoate, dicyclohexylamine nitrate, benzotriazole, and other types of corrosion inhibitors etc, and mixtures thereof, see abstract, Example V and the examples VI-VIII.

Miksic et al discloses vapor phase corrosion inhibitors-desiccant material for inhibiting corrosion on a metal surface. The corrosion inhibitors used in the composite compositions can be selected from benzoate, trialkanolamine, benzotriazole, and other types of corrosion inhibitors etc, and mixtures thereof, see abstract, column 7, lines 33-63, examples and claims.

All the above said patents differ from applicant's claimed invention in that they do not directly teach (i.e. by way of an example) a corrosion inhibiting composition that actually comprises applicant's components (a), (b) and (c) within applicant's claimed concentration weight ratios. It would have been obvious to one having ordinary skill in the art to use the individual disclosures of each applied patent as strong motivation to make corrosion inhibiting compositions that actually comprise applicant's claimed components (a), (b) and (c) within applicant's claimed weight ratios since such weight ratios extensively overlap the suggested weight concentration ranges of applicant's components (a), (b) and (c) as set forth in the cited sections of each patent. The use of mixtures of corrosion inhibitors, such as applicant's claimed mixtures of (a), (b), and (c), is either directly taught (i.e. by the examples) of each patent or are strongly suggested by the disclosure of each patent in said cited patent section as list above.

Prior-Art Cited But Not Applied

12. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

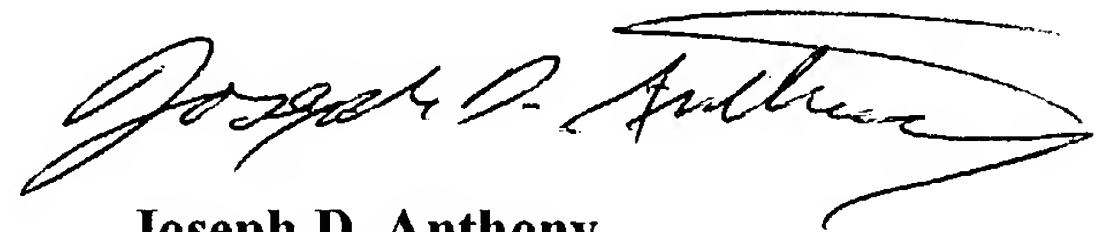
Examiner Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number

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is (571) 272-1117. This examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 6:30 p.m. in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (703) 872-9306. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

9/7/04